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REMARKS

This response is intended as a full and complete response to the non-final Office Action mailed May 18, 2007. In the Office Action, the Examiner notes that claims 1-5, 7, 9-26, 28, 30-47, 49 and 51-63 are pending and rejected. By this response, Applicant herein amends claims 1, 3-5, 9, 12-19, 21, 22, 24-26, 30, 33-40, 42, 43, 45-47, 51, 54-61 and 63 and cancels claims 2, 10, 11, 23, 31, 32, 44, 52 and 53. The support for the amendments to independent claims 1, 22 and 43 may be found in the Applicant's specification on at least page 70, lines 15-16. The support for claims 3-5, 9, 19, 21, 24-26, 30, 40, 42, 45-47, 51, 61 and 63 may be found in the Applicant's specification on at least page 71, lines 1-4. The support for the remaining dependent claims was made to correlate to the amendment to the independent claims.

In view of the foregoing amendments and the following discussion, Applicant submits that none of the claims now pending in the application are obvious under the provisions of 35 U.S.C. §103. Thus, Applicant believes that all of these claims are now in allowable form.

Applicant, by amending the claims, does not acquiesce to the Examiner's characterizations of the art of record or to Applicant's subject matter recited in the pending claims. Further, Applicant is not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant response including amendments.

STATEMENT OF SUBSTANCE OF INTERVIEW

Applicant thanks the Examiner for the courtesies shown during the telephone interview on February 23, 2007. The Examiner and Applicant's representative discussed that the amendments to the independent claims would result in the dependent claims broadening, rather than narrowing the dependent claims. The Examiner informed the Applicant that an Examiner's amendment would be inappropriate.

In response, the Applicant herein amends the dependent claims to further narrow the independent claims as written with the amendments filed on December 18, 2006.

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OBJECTIONS

Claims 2-5, 8-11, 19-21 and 30 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Responsive to the Examiner, the Applicant herein amends claims 2-5, 8-11, 19-21, 30 and other similar dependent claims not listed by the Examiner to properly further limit the subject matter of a previous claim. Therefore, the Applicant respectfully requests the objection be withdrawn.

REJECTIONS

35 U.S.C. §103 Rejection of Claims 1-5, 7, 9, 12-14, 16, 19-26, 28, 29, 30, 33-35, 37, 40-47, 49, 50, 51, 54-56, 58, 61-63

The Examiner has rejected claims 1-5, 7, 9, 12-14, 16, 19-26, 28, 29, 30, 33-35, 37, 40-47, 49, 50, 51, 54-56, 58, and 61-63 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,553,178-B2 to Abecassis in view of U.S. Patent 6,510,209 to Cannon, U.S. Patent 6,141,058 to Lagoni, and U.S. Patent 5,729,280 to Inoue and the MSN Web Messenger Reference (hereinafter "MSN"). Applicant notes that claims 29 and 50 were canceled. Regardless, the Applicant respectfully traverses the rejection.

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art, and there must be motivation to combine the cited references in a manner to obviate the claimed invention.

Applicant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness of the claimed invention because Abecassis, Cannon, Lagoni, Inoue and MSN, alone or in combination, fail to teach or suggest all of the limitations recited in amended independent claims 1, 22 and 43, and thus fail to teach or suggest Applicant's invention as a whole.

Specifically, Abecassis, Cannon, Lagoni, Inoue and MSN, alone or in combination, fail to teach or suggest at least "pausing the outputting of the live video program immediately upon detecting the occurrence of the incoming request for communications and determining that an originator of the incoming request for communications comprises any of the at least one predetermined originators" and "the

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request comprises an e-mail, wherein the e-mail is detected via an e-mail communications software” as recited in claim 1, and as substantially similarly recited in claims 22 and 43. Advantageously, the Applicant’s invention prevents a user from missing any portions of a live video program when the user receives an incoming request for communications.

Abecassis fails to teach or suggest pausing the outputting of a live video program immediately upon detecting the occurrence of the incoming request for communications and determining that an originator of the incoming request for communications comprises any of the at least one predetermined originators. Abecassis specifically teaches that the video program is paused if the viewer accepts the call. (See Abecassis, col. 52, ll. 18-20, emphasis added.) If the viewer does not accept the call the video transmission is not paused. (See *Id.* at ll. 27-33, emphasis added.) In contrast, Applicant’s present invention claims only one of the multiple embodiments of the disclosed in Applicant’s specification. Specifically, the embodiment claimed is the embodiment where the video program is immediately paused upon detecting the occurrence of an incoming request for communications. No action is required by the user to pause the video program.

Notably, Applicant’s invention teaches a second embodiment which is similar to Abecassis in that “a triggering event”, such as answering the call, must be detected before pausing. (See Applicant’s specification, p. 77, ll. 3-21.) However, the embodiment presently claimed, reciting “pausing the outputting of the video program immediately upon detecting the occurrence of an incoming request for communications,” is not so broad as to encompass Abecassis’ teaching of requiring the call to be answered before pausing the video program. Moreover, Abecassis does not teach or suggest any request comprising an e-mail, where the e-mail is detected via an e-mail communications software.

Cannon, Lagoni, Inoue and MSN fail to bridge the substantial gap between Abecassis and Applicant’s invention. Cannon discloses a telephone enabling remote programming of a video recording device. Cannon discloses that a VCR or videodisk player can be paused upon receipt of an incoming phone call. Cannon does not teach or suggest pausing the outputting of a live video program immediately upon detecting the occurrence of the incoming request for communications and determining that an

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originator of the incoming request for communications comprises any of the at least one predetermined originators or any request comprising an e-mail, wherein the e-mail is detected via an e-mail communications software.

The Examiner asserts that Cannon teaches immediately pausing a movie when a user receives a phone call on column 2, lines 41-65. The Applicant respectfully submits that Cannon teaches pausing a movie played from a tape or disk on a VCR and not a live video program. (See *Id.*) Notably, the primary function of a VCR is to control a tape or disk utilizing commands such as pause, play, fast forward and rewind. However, typically live video programs cannot be paused. Thus, the Applicant's claims provide a novel feature.

Furthermore, even if Cannon was somehow interpreted as pausing a live video program, Cannon and Abecassis cannot be meaningfully combined because Cannon teaches away from Abecassis. As discussed above, Abecassis teaches that the video program is paused if the viewer accepts the call. (See Abecassis, col. 52, ll. 18-20, emphasis added.) If the viewer does not accept the call the video transmission is not paused. (See *Id.* at ll. 27-33, emphasis added.) In stark contrast, as the Examiner asserts, Cannon teaches that a VCR playing a tape or disk is paused upon receiving a telephone call. The Applicant respectfully submits that these two embodiments are mutually exclusive and cannot be meaningfully combined.

Lagoni discloses a television receiver includes a telephone network interface circuitry which allows the receiver to receive and process Caller-ID signals for display during ringing period of the telephone set. Lagoni does not teach or suggest pausing the outputting of the video program immediately upon detecting the occurrence of the incoming request for communications and determining that an originator of the incoming request for communications comprises any of the at least one predetermined originators or any request comprising an e-mail, wherein the e-mail is detected via an e-mail communications software.

Inoue discloses a near video-on-demand signal receiver having a pause function in the display of the video program by temporarily storing a segment of the video program equal to the length of the transmission interval and obtaining the remainder of the program at a later time from the same of another channel. Specifically, Inoue discloses that a user enters a pause command into the user interface (i.e., col. 7, ll. 64-

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65). Inoue does not teach or suggest pausing the outputting of the video program immediately upon detecting the occurrence of the incoming request for communications and determining that an originator of the incoming request for communications comprises any of the at least one predetermined originators or any request comprising an e-mail, wherein the e-mail is detected via an e-mail communications software.

The Office Action states Abecassis, Cannon, Lagoni and Inoue fail to teach or suggest detecting an incoming email message. Applicant agrees. MSN fails to bridge the substantial gap left by Abecassis, Cannon, Lagoni and Inoue because MSN only discloses an instant messaging service that automatically notifies you when you receive a new message in your hotmail e-mail account. MSN does not teach or suggest that anything is paused in response to the automatic notification. For example, combining MSN with Abecassis, Lagoni and Inoue or with Cannon, Lagoni and Inoue may simply teach that a live video program continually plays behind the instant message notification. Without more, the Applicant respectfully submits that the Examiner is using impermissible hindsight to assume that the instant message notification may immediately pause a live video program.

In addition, MSN only teaches the use of instant messages and not e-mails. Thus, MSN does not teach or suggest any request comprising an e-mail, wherein the e-mail is detected via an e-mail communications software as claims.

As a result, none of the cited references teach or suggest "pausing the outputting of the video program immediately upon detecting the occurrence of the incoming request for communications and determining that an originator of the incoming request for communications comprises any of the at least one predetermined originators" or "the request comprises an e-mail, wherein the e-mail is detected via an e-mail communications software". Therefore Abecassis, Cannon, Lagoni, Inoue and MSN, alone or in any combination, fail to disclose or suggest Applicant's invention as a whole.

Claims 2-5, 7, 9, 12-14, 16, 19-21, 23-26, 28, 30, 33-35, 37, 40-42, 44-47, 49, 51, 54-56, 58, and 61-63 depend directly or indirectly from independent claims 1, 22 and 43. Claims 29 and 50 are canceled. Therefore, Applicant respectfully requests that the Examiner's rejection be withdrawn.

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35 U.S.C. §103 Rejection of Claims 10-11, 31, 32, 52 and 53

The Examiner has rejected claims 10-11, 31, 32, 52 and 53 as being unpatentable over Abecassis in view of Cannon, Lagoni, Inoue and MSN in further view of U.S. Patent 6,349,410 to Lortz (hereinafter "Lortz"). Applicant respectfully traverses the rejection.

Claims 10-11, 31, 32, 52 and 53 depend directly or indirectly from independent claims 1, 22 and 43. Moreover, for at least the reasons discussed above, Abecassis, Cannon, Lagoni, Inoue and MSN fail to teach or suggest Applicant's invention as recited in claims 1, 22 and 43. Accordingly, any attempted combination of Abecassis, Cannon, Lagoni and Inoue with any other additional references, in a rejection against the dependent claims, would still result in a gap in regards to the rejection against the independent claims. As such, Applicant submits that dependent claims 10-11, 31, 32, 52 and 53 are not obvious and are patentable under 35 U.S.C. §103. Therefore, Applicant respectfully requests that the Examiner's rejection be withdrawn.

35 U.S.C. §103 Rejection of Claims 15, 36 and 57

The Examiner has rejected claims 15, 36 and 57 as being unpatentable over Abecassis in view of Cannon, Lagoni, Inoue and MSN in further view of U.S. Patent 6,543,053 to LI (hereinafter "LI"). Applicant respectfully traverses the rejection.

Claims 15, 36 and 57 depend directly or indirectly from independent claims 1, 22 and 43. Moreover, for at least the reasons discussed above, Abecassis, Cannon, Lagoni, Inoue and MSN fail to teach or suggest Applicant's invention as recited in claims 1, 22 and 43. Accordingly, any attempted combination of Abecassis, Cannon, Lagoni and Inoue with any other additional references, in a rejection against the dependent claims, would still result in a gap in regards to the rejection against the independent claims. As such, Applicant submits that dependent claims 15, 36 and 57 are not obvious and are patentable under 35 U.S.C. §103. Therefore, Applicant respectfully requests that the Examiner's rejection be withdrawn.

35 U.S.C. §103 Rejection of Claims 17, 38 and 59

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The Examiner has rejected claims 17, 38 and 59 as being unpatentable over Abecassis in view of Cannon, Lagoni, Inoue and MSN in further view of U.S. Patent 6,052,508 to Mincy (hereinafter "Mincy"). Applicant respectfully traverses the rejection.

Claims 17, 38 and 59 depend directly or indirectly from independent claims 1, 22 and 43. Moreover, for at least the reasons discussed above, Abecassis, Cannon, Lagoni, Inoue and MSN fail to teach or suggest Applicant's invention as recited in claims 1, 22 and 43. Accordingly, any attempted combination of Abecassis, Cannon, Lagoni and Inoue with any other additional references, in a rejection against the dependent claims, would still result in a gap in regards to the rejection against the independent claims. As such, Applicant submits that dependent claims 17, 38 and 59 are not obvious and are patentable under 35 U.S.C. §103. Therefore, Applicant respectfully requests that the Examiner's rejection be withdrawn.

35 U.S.C. §103 Rejection of Claims 18, 39 and 60

The Examiner has rejected claims 18, 39 and 60 as being unpatentable over Abecassis in view of Cannon, Lagoni, Inoue and MSN in further view of the ReplayTV manual (hereinafter "ReplayTV"). Applicant respectfully traverses the rejection.

Claims 18, 39 and 60 depend directly or indirectly from independent claims 1, 22 and 43. Moreover, for at least the reasons discussed above, Abecassis, Cannon, Lagoni, Inoue and MSN fail to teach or suggest Applicant's invention as recited in claims 1, 22 and 43. Accordingly, any attempted combination of Abecassis, Cannon, Lagoni, Inoue and MSN with any other additional references, in a rejection against the dependent claims, would still result in a gap in regards to the rejection against the independent claims. As such, Applicant submits that dependent claims 18, 39 and 60 are not obvious and are patentable under 35 U.S.C. §103. Therefore, Applicant respectfully requests that the Examiner's rejection be withdrawn.

CONCLUSION

Thus, Applicant submits that none of the claims presently in the application are obvious under the provisions of 35 U.S.C. §103. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

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If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall or Jimmy Kim, at (732) 530-9404, so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

Dated: 8/3/07



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